

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Hubert ELMER et al.

Serial No.: 10/509,822

Filed: September 30, 2004

For: Separating Wall

Examiner: CHAPMAN, J. E.

Group Art: 3635

Mail Stop **Appeal Brief - Patents**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

SIR:

This is an appeal, pursuant to 37 C.F.R. § 41.37, from the decision of the Examiner in the above-identified application, as set forth in the Final Office Action issued April 18, 2008, in which the Examiner finally rejected appellants' claims. The rejected claims are reproduced in the Appendix A attached hereto. A Notice of Appeal was timely filed in the subject application on August 18, 2008 by first class mail and received by the USPTO on August 21, 2008, along with a Request for Pre-Appeal Brief Review. A Panel Decision was issued on September 17, 2008 holding that the subject application remains under appeal because there is at least one actual issue for appeal.

The fee of \$ 540.00 for filing an Appeal Brief pursuant to 37 C.F.R. § 41.20 is submitted herewith. Any additional fees or charges in connection with this application may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

I. REAL PARTY IN INTEREST

The assignee, Dorma GmbH + Co. KG, of applicants, Hubert ELMER et al., is the real party of interest in the above-identified U.S. Patent Application.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals and/or interferences related to the above-identified application at the present time.

III. STATUS OF CLAIMS

Claims 1-9 and 15-16 have been cancelled during prosecution. Claims 10-14 and 17-21 have been amended during prosecution. Claims 10-14 and 17-21 have been rejected and are on appeal.

IV. STATUS OF AMENDMENTS

A Request for Reconsideration was filed on July 16, 2008 subsequent to the Final Office Action. The Examiner found the arguments not persuasive as indicated in the Advisory Action issued July 31, 2008. No claim amendments were filed subsequent to the Final Office Action.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The following descriptive details are based on the subject matter described in the specification. They are provided only for the convenience of the Board as part of the discussion presented herein, and are not intended to argue limitations which are unclaimed. Figure 1 is reproduced below for the Boards' convenient reference.

Appellants' invention is directed to a glass separating wall (1) comprising a pair of frameless side panels (4) mounted between a top structure (2) and a base (3). Top structure (2) and the base (3) have respective channels (8, 9), in which the side panels (4) engage. (*See, e.g.*, para. [0016], ll. 2-4 and 8-9; and para. [0018], ll. 6-7 of the specification as filed.)

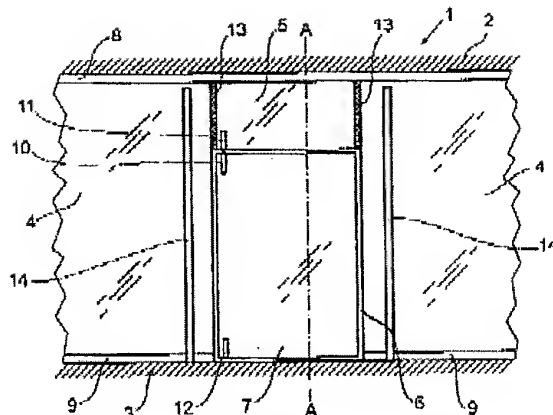


Fig. 1

The glass separating wall (1) also comprises a frameless transom panel (5) arranged between the side panels (4) and engaged in the channel (8) at the top structure (2). (*See, e.g., para. [0018], ll. 1-4 of the specification as filed.*) A permanently elastic mass (13) is arranged in the channels (8, 9) and between the transom panel (5) and the side panels (4), so that the transom panel (5) is connected in frictional engagement with the side panels (4) and the top structure (2) by the elastic mass (13), and that the side panels (4) are connected in frictional engagement with the top structure (2) and the base (3) by the elastic mass (13). (*See, e.g., para. [0018], ll. 1-7 of the specification as filed.*)

A rotatable door leaf (7) is arranged below the transom panel (5) and between the two side panels (4). (*See, e.g., para. [0016], ll. 4-7 of the specification as filed.*) The door leaf (7) is rotatably supported exclusively at the transom panel (5) and the base (3) by fittings (10, 11, 12). The fittings (10, 11, 12) comprise complementary first and second fitting parts (10, 11), with the first fitting part (10) being fixed to the door leaf panel (7) and said second fitting part (11) being fixed directly to the transom panel (5). The first and second fitting parts (10, 11) cooperate to permit rotation of the door leaf (7). (*See, e.g., para. [0017], ll. 2-3 and 5-6 of the specification as filed.*)

The side panels (4) and the transom panel (5) are fastened to one another and to the top structure (2) and the base (3) independently from the fittings (10, 11, 12), which support the rotatable door leaf (7). (*See, e.g., para. [0018], ll. 1-7 of the specification as filed.*)

VI. GROUNDS OF REJECTION TO BE REVIEWED IN APPEAL

1. Whether claims 10-14 and 17-20 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over *WO 94/27019 (WO '019)* in view of *DE 3425765 (DE '765)* and U.S. Patent 4,912,898 (*Holmes*).¹

2. Whether claim 21 was properly rejected under 35 U.S.C. § 103(a) as being unpatentable over *WO '019* in view of *DE '765*, U.S. Patent 3,685,240 (*Oscari*) and *Holmes* and further in view of JP 2003268907A (*JP '907*).

VII. ARGUMENT

1. Rejection of claims 10-14 and 17-20

A. Independent Claim 10 Is Not Obvious Over The Cited Art

Independent claim 10 recites, at least, “a permanently elastic mass arranged between the transom panel and the side panels and in the channels” and “the transom panel being connected in frictional engagement with the side panels and with the top structure by the permanently elastic mass.”

Independent claim 10 is not obvious over the cited art for the following reasons:

(i) the combined art does not disclose the above features recited in independent claim 10 because the glass panel assemblies in *Holmes* are not connected by the exterior sealant 58, as is found in the Final Office Action, but rather by an interior frame work member such as a mullion 45; and

(ii) there is no motivation for one skilled in the art to modify the connectors of *WO '019* with *Holmes's* teachings of butt joints, as is proposed in the Final Office Action, as such proposed modification of *WO '019* would change its principle of operation and is thus prohibited (*see*, MPEP § 2143.01 VI).

¹ U.S. Patent 3,685,240 to *Oscari* is believed to have been relied on for this rejection.

(i)

WO '019 concerns a connector for securing plate-like wall components. In *WO '019*, the connector is formed so that it requires only a centering and/or semicircular hole, instead of complex cutouts, in the glass plates. More specifically, the connectors of *WO '019* are designed as connector halves 10, 15, 22, which are adapted to be inserted into the hole in the glass plate from both sides and are then bolted together, *e.g.*, by means of a threaded fitting. *See*, page 3 of the English translation.

The Examiner acknowledges that *WO '019* “lacks the permanently elastic mass between the transom panel and the side panels and the transom panel being connected in frictional engagement with the side panels by the permanently elastic mass” (*see*, page 4 of the Final Office Action). The Examiner then cites *Holmes* for its alleged teachings of a permanently elastic mass 53/58 and takes the position that it would have been obvious to one skilled in the art to apply such alleged teachings in *Holmes* to *WO '019* to arrive at the invention recited in independent claim 10. Appellants respectfully disagree.

Holmes teaches forming glass panel assemblies 10a, 10b and securing the same to mullions 45, which is connected to a building's supporting structure. For example, *Holmes* teaches that the glass panel assembly 10a is positioned against the mullion 45, as is shown by phantom lines “C” and the repositioned as indicated by solid lines “D” in Fig. 4. Once assembly 10a is properly positioned, it may be secured to mullion 45, as is shown in Fig. 5. For example, the glass panel assembly 10a can be glazed to the mullion 45 by glazing compounds or sealant 55 (*see*, col. 8, ll. 24-27 of *Holmes*).

Similarly, a second assembly 10b can then be positioned adjacent to the first assembly 10a and secured to mullion 45. An exterior sealant 58 is used to produce a glazed exterior butt joint of superior appearance and strength (*see*, col. 9, ll. 7-15 of *Holmes*).

Since the adjacent glass panel assemblies 10a, 10b in *Holmes* are connected next to each other by the mullion 45, there is no teaching in *Holmes* that the adjacent glass panel assemblies 10a, 10b are connected to each other by the exterior sealant 58, as asserted in the Final Office Action. Thus, the combination of WO '019 and *Holmes* fails to teach or suggest "the transom panel being connected in frictional engagement with the side panels and with the top structure by the permanently elastic mass" as recited in independent claim 10.

Therefore, *Holmes* does not remedy the deficiencies of WO '019 for at least the above reasons.

(ii)

Moreover, appellants submit that one skilled in the art will not be motivated to substitute the alleged permanently elastic mass 53/58 in *Holmes* for the connectors in WO '019 as is suggested in the Final Office Action.

As appellants submitted above, WO '019 is conceived to form its connectors as connector halves 10, 15, 22, which are adapted to be inserted into the hole in the glass plate from both sides and are then bolted together. If such connectors in WO '019 are replaced by the alleged permanently elastic mass 53/58 taught by *Holmes*, as is suggested in the Final Office Action, then not only the principle of operation of the connectors disclosed in WO '019 will be altered but the underlying invention disclosed in WO '019 will be null. Consequently, such proposed modification of WO '019 is neither conceivable by one skilled in the art nor permissible under MPEP § 2143.01VI. Accordingly, it is not obvious apply the teachings of permanently elastic mass 53/58 in *Holmes* to WO '019 to arrive at the invention recited in independent claim 10.

Therefore, *Holmes* does not remedy the deficiencies of WO '019 for the above additional reasons.

DE '765 and *Oscari* are cited in the Office Action concerning other features recited in independent claim 10 and thus do not remedy the above deficiencies of *WO '019*.

In view of all the above, the combined cited art does not teach “a permanently elastic mass arranged between the transom panel and the side panels and in the channels” and “the transom panel being connected in frictional engagement with the side panels and with the top structure by the permanently elastic mass” as recited in independent claim 10. The Final Office Action thus failed to establish a *prima facie* case of obviousness with respect to independent claim 10. Therefore, the Final Rejection of independent claim 10 should be reversed.

B. Dependent Claims 11-14 and 17-20 Are Allowable

Dependent claims 11-14 and 17-20 are patentable for at least the same reasons that independent claim 10 is patentable, as well as for the additional limitations recited therein. The Final Rejection of claims 11-14 and 17-20 should be reversed.

2. Rejection of Claim 21 as Obvious Over The Cited Art

Claim 21 recites that “the transom panel is fastened to the side panels and the top structure solely by the permanently elastic mass.” The Final Office Action takes the position that “JP 907 discloses glazing panels 10 secured to each other 100 and the other structure 12 only by elastic mass 30.” Appellants respectfully disagree.

In the English abstract, *JP '907* teaches that the “panels are supported by the metal support (12) arranged at four sides of the panel, at preset interval.” Accordingly, the glass panels 10 in *JP '907* are not only connected by the sealing joint 30 but also supported by the metal support 12. Therefore, *JP '907* does not teach that “the transom panel is fastened to the side panels and the top structure solely by the permanently elastic mass,” as is recited in claim 21.

In view of the above, the Final Office Action failed to establish a *prima facie* case of obviousness with respect to claim 21. The Final Rejection of claim 21 should be reversed.

VIII. CONCLUSION

For the foregoing reasons, appellants respectfully submit that claims 10-14 and 17-21 are not obvious over and are, therefore, patentable over the art of record. The Examiner's Final Rejections should be reversed.

Respectfully submitted,

COHEN PONTANI LIEBERMAN & PAVANE LLP

By / Alfred W. Froebrich /
Alfred W. Froebrich
Reg. No. 38,887
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

Dated: October 21, 2008

CLAIMS APPENDIX

Claims 1-9, 15-16 have been previously canceled. Claims 10-14 and 17-22 are pending in this case and are listed below:

10. A glass separating wall comprising:

a pair of frameless side panels mounted between a top structure and a base, each of the top structure and the base having a channel, the side panels engaging in the channels;

a frameless transom panel arranged between the side panels and engaging in the channel at the top structure;

a permanently elastic mass arranged between the transom panel and the side panels and in the channels, the transom panel being connected in frictional engagement with the side panels and with the top structure by the permanently elastic mass, the side panels being connected in frictional engagement with the top structure and the base by the permanently elastic mass; and

a rotatable door leaf between the side panels and below the transom panel, the door leaf being rotatably supported exclusively at the transom panel and the base by fittings, said fittings comprising complementary first and second fitting parts, said first fitting part being fixed to the door leaf panel and said second fitting part being fixed directly to the frameless transom panel, said first and second fitting parts cooperating to permit rotation,

wherein the side panels and the transom panel are fastened to one another and to the top structure and the base independently from the fittings which support the rotatable door leaf.

11. The glass separating wall of claim 10, wherein the side panels, the transom panel, and the door leaf have a uniform grid dimension.

12. The glass separating wall of claim 10, wherein the side panels, the transom panel, and the door leaf are arranged in a common plane.

13. The glass separating wall of claim 10, wherein said fittings further comprise complementary fitting parts at a bottom of the door leaf and the base.

14. The glass separating wall of claim 10, wherein the side panels and the transom panel each have longitudinal abutting edges, the abutting edges of the transom panel being connected to the abutting edges of respective said side panels by the permanently elastic mass.

17. The glass separating wall of claim 10, wherein the permanently elastic mass is made of at least one of silicone and acrylic.

18. The glass separating wall of claim 10, further comprising vertically oriented stiffening elements supported on the base and arranged against the side panels perpendicularly to the side panels.

19. The glass separating wall of claim 10, wherein the side panels and the transom panel are glass panels.

20. The glass separating wall of claim 10, wherein one of said first and second fitting parts comprises a pin and the other of said first and second fitting parts comprises a bearing brush which receives said pin.

21. The glass separating wall of claim 10, wherein the transom panel is fastened to the side panels and the top structure solely by the permanently elastic mass.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.